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Morgan & Finnegan
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EXAMINER

MYHRE, JAMES W

| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/598,458

Applicant(s)
Hamor et al

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 31, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed on March 31, 2003 under 37 CFR 1.111 has been considered but is ineffective to overcome the Angles et al (5,933,811), Gerszberg et al (6,044,403), and Logan et al (5,721,827) references.

Claim Rejections - 35 USC § 112

2. The amendment filed on March 31, 2003 corrected the antecedent basis rejection of Claim 53. Therefore, the Examiner hereby withdraws that rejection.

3. Claims 37, 39, 50, 54, 56, and 65 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for client actions include delivering, printing, saving, and transmitting a content page, does not reasonably provide enablement for counting such client impressions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. It is unclear whether only one client impression is being counted for completing all four actions, one client impression is being counted for each of these actions, or some combination thereof. The Examiner notes that, if each action is counted, it is unlikely that an advertiser would be willing to pay extra (for additional client impressions) for activities the

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client is doing on the content page unless his advertisement is being displayed more than once or for a longer period of time. The Examiner also notes that the customer could print, save, and transmit the content page without the advertisement being included therein, since each is a separate file. Likewise, if all four actions need to be completed before a client impression is counted, it is unlikely that the content provider would be willing to display an advertisement if the payment was only received if the customer completed all four of the above actions. Lastly, the Examiner further notes that the criteria used to determine how to count what constitutes a "client impression" is a design decision agreed upon by the parties involved during contract negotiations and does not affect the claimed steps in providing a targeted advertisement to a customer when that customer accessing content data on a website.

Claim Objections

4. The amendment filed on March 31, 2003 corrected the dependency deficiency noted in Claims 75-77 in paragraph 3 of paper number 7. Therefore, the Examiner hereby withdraws that objection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-10, 12-15, 30-36, 38, 44-49, 51-53, 55, 64, and 82-91 are rejected under 35

U.S.C. 102(e) as being anticipated by Angles et al (5,933,811).

Claims 1, 30, 47-49, 51-53, 55, 64, 82-86, and 92-98: Angles discloses a system and method for delivering customized advertisements over interactive communication networks, comprising:

- a. Transmitting a controlling program to a client requesting content data (col 3, lines 25-29);
- b. Transmitting a content page to the client from a content provider (col 3, lines 9-17;
- c. Receiving client impressions (interactions) to the content page (col 3, line 66 - col 4, line 5); and
- d. Calculating content provider revenue based on the total number of client impressions from the content provider (col 4, lines 18-26).

The Examiner notes that Angles discloses that the advertisement provider bills a plurality of advertisers (col 4, lines 3-5) and then monitors the number of advertisements viewed by

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consumers associated with a particular content provider so the advertisement provider can pay the content providers “based on the number of consumers who access their websites” (col 4, lines 20-22). Angles also discusses using the money collected from the plurality of advertisers to “pay an Internet provider based on the number of advertisements viewed by its consumers. The Internet provider can then use this advertising revenue to reduce the consumer access fees” (col 4, lines 43-46). Thus, Angles implies that the advertisement provider maintains a “revenue pool” which contains monies collected from revenue sources (e.g. advertisers) and which is used to periodically pay the content providers (and others).

Claims 2-6 and 87-91: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 85 above, and further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

Claims 7-10 and 32-35: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the client impressions include delivering, printing, saving, or transmitting (col 16, lines 1-34).

Claims 12-14, 38, and 46: Angles discloses a system and method for delivering customized advertisements over interactive communication networks as in Claim 1 above, and further discloses targeting the advertisement based upon the client profile, accessed content, or the content page (col 15, lines 22-28).

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Claims 15, 31, 44, and 45: Angles discloses a system, method, and computer program for delivering customized advertisements over interactive communication networks as in Claims 1 and 30 above, and further discloses that the total revenue pool comprises the total number of advertisements multiplied by the price per advertisement (col 16, lines 1-34).

Claim 36: Angles discloses a method for delivering customized advertisement over interactive communication networks as in Claim 30 above, and further discloses that the client impressions include searching (col 16, lines 1-34).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811).

Claim 11: Angles discloses a method for delivering customized advertisements over interactive communication networks as in Claim 1 above, but does not explicitly disclose that the host is always visible to the client when active. Official Notice is taken that it is old and well known within the computer arts to assign priorities to the windows being displayed to a client.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place a high priority on the host window to make it always visible to the client. One would have been motivated to keep the host visible to the client in order to increase the exposure of the client to the advertisement. Since the Applicant did not refute the above Official Notice in the response to the previous office action, it is taken as an indication of agreement that the feature is old and well known within the art.

9. Claims 16-29, 40-43, 57-63, and 66-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Logan et al (5,721,827).

Claims 16, 17, 27, 40, 42, and 43: Angles discloses a system and method for delivering customized advertisement over interactive communication networks, comprising:

- a. Grouping advertisements according to topic, user profiles, or other criteria (col 15, lines 39-42 and col 20, lines 59-63);
- b. Assigning/transmitting a controlling program to a client (col 3, lines 25-29 and col 13, lines 61-67); and
- c. Transmitting a plurality of advertisements to the controlling program (col 15, lines 28-31).

Angles does not explicitly disclose that the plurality of advertisements are organized into an advertising wheel (i.e. queue), nor that the advertisements in the queue are transmitted to the controlling program in succession. Angles does, however, disclose updating the customized

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advertisement being viewed "if a particular consumer views a particular electronic page 32 for more than a minute, the advertising module 52 can send a new customized advertisement 30" (col 20, lines 11-17). Logan discloses a similar system and method for delivering customized advertisements over interactive communication networks and also discloses organizing the plurality of advertisements into a queue and transmitting a plurality of advertisements to the client in sequence from the queue (col 9, lines 57-63). Since an advertisement only appears once in the queue, it is inferred that the advertisement will only be transmitted once during each cycle of the queue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to organize linked advertisements in Angles into one or more advertising wheels/queues and to transmit each advertisement in the queue to the client in sequence once during each cycle of the queue. One would have been motivated to use an advertising wheel/queue in this manner in order to enable the system to present serial advertisements (similar to the old Burma Shave commercials alongside of American roadways for the past 50-60 years) in the proper sequence, to update the customized advertisement by sending the "new customized advertisement" in Angles without having to reinitiate the targeting sequence, and to preclude the repetitive delivery of the same advertisement.

Claim 18: Angles and Logan disclose a method for delivering customized advertisement over interactive communication networks as in Claim 16 above. Logan further discloses placing all of the similarly classified advertisements into one large queue (col 9, lines 57-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made

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to place all of the similar advertisements in Angles in one large queue. One would have been motivated to use one large queue in order to ensure that an advertisement is not transmitted to the client more than once before all other similar advertisements have been transmitted.

Claims 19-26, 41, 57-63, and 66-73: Angles and Logan disclose a system and method for delivering customized advertisements over interactive communication networks as in Claims 18 and 40 above. Logan further discloses that advertisements on one queue are subdivided into linked auxiliary wheels (sub-queues, according to various similar features (col 24, line 1 - Col 26, line 3)). The various claimed features used to divide the advertisements are among the usual features used by advertisers when deciding how to target clients. The exact individual feature, or group of features, selected by the advertiser is a design decision which does not affect the steps of the invention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to subdivide the advertisements in Angles into any number of linked sub-queues, based on whichever features the advertiser desires. One would have been motivated to subdivide the advertisements and to link the sub-queues in order to better target the advertisements to the client.

Claims 28 and 29: Angles and Logan disclose a method for delivering customized advertisements over interactive communication networks as in Claim 16 above. Angles further discloses that the control functions include printing, saving, transmitting, and/or searching (col 20, lines 21-26 and col 23, lines 9-35).

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10. Claims 77-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al (6,044,403).

Claims 74 and 78: Gerszberg discloses a method for sending coupons to a client on a network, comprising:

- a. Transmitting a host with a face value (i.e. coupon) to a client (col 12, lines 18-48);
- b. Storing the coupon in the client's memory (col 12, lines 18-48); and
- c. Transmitting the coupon to a remote location (i.e. merchant), wherein the client receives a discount on goods or services according to the face value of the coupon (col 12, lines 18-48).

The Examiner considers the merchant as another client on the network. Thus, transmitting the coupon to the merchant is the equivalent of exchanging the coupon with another client. Additionally, since the coupon is being stored as a file in the client's memory (whether on a smart card or as part of some other type of client storage device) and no type of security procedure is disclosed which would prevent the transmission or copying of the file, it is obvious that the client could exchange (transmit and receive) these coupon files with any other client on the network to include other customers. One would have been motivated to allow customers to exchange of the coupon files in order to increase the likelihood of the coupon being redeemed.

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Claims 75 and 79: Gerszberg discloses a method for sending coupons to a client on a network as in Claims 74 and 78 above, and further discloses that the value of the coupon may vary while stored on the client's memory (col 12, lines 18-48).

Claims 76, 77, 80, and 81: Gerszberg discloses a method for sending coupons to a client on a network as in Claims 74 and 78 above, but does not explicitly disclose that the value is an interest rate or a time value discount. Official Notice is taken that it is old and well known that coupons may consist of any number of innumerable terms to include, cents-off discounts, percentage discounts, rebates, various time sensitive terms, buy-one-get-one-free discounts, etc. Again, the exact terms and types of values offered would be a design decision made by each individual advertiser and would not affect the claimed delivery method. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the coupons being delivered in Gerszberg could contain any of these known terms to include an interest rate or a time value discount. One would have been motivated to allow the coupons to have various types of terms in order to expand the utility of the coupon delivery system to cover many types of advertisers. Since the Applicant did not refute the above Official Notice in the response to the previous office action, it is taken as an indication of agreement that the feature is old and well known within the art.

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Response to Arguments

11. Applicant's arguments filed March 31, 2003 have been fully considered but they are not persuasive.

A. Applicant argues in reference to Claims 1, 30, 38, 44, 46, 64, and 85 that Angles does not disclose a revenue pool from which the content providers are paid, the revenue pool being funded by the advertisers (page 17). The Examiner notes that this has been discussed in detail in the above rejection of these claims above. Angles receives monies from the advertisers into the advertisement provider's account, and then pays the content providers from the advertisement provider's account. This account is used to receive payments from all of the advertisers and to provide payment to all of the content providers. Thus, it is a "revenue pool". Angles further discloses sending each advertiser a bill based on the number of client impressions and sending payment to each content provider based on the number of client impressions. Therefore, the advertisement provider does not, as claimed by the Applicant, "credits a consumer account, a content provider account and an Internet provider account each time a consumer views a customer advertisement" (page 17).

B. The Applicant also argues in reference to Claim 55 that Angles does not disclose "that a host is transmitted to a client and embedded" (page 18). The Examiner notes that Angles that the consumer computer contains a "software plug-in on the consumer computer 12 called the consumer control module 42", which "is a plug-in that works in conjunction with the consumer browser" (col 23, lines 8-15). It is further discloses that "the consumer is sent unique software

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which enhances the consumer's Internet browser so that custom advertisements can be merged with electronic documents obtained from the content provider" (col 3, lines 25-29). Therefore, Angles explicitly discloses that the host (plug-in module) is transmitted and embedded onto the client's computer.

C. The Applicant argues in reference to Claims 74, 75, 78, and 79 that Gerszberg does not disclose "a service related to the exchange of coupons between users on a network" (page 19). This argument has been considered but is moot in view of the new grounds of rejection above.

D. The Applicant's argument in reference to Claim 37, 39, 50, 54, 56, and 65 has been considered but is moot in view of the new grounds of rejection above.

E. The Applicant argues in reference to Claims 16-29 that Angles does not teach grouping and subdividing advertisements from a plurality of advertisers according to topic, user profiles or other criteria (page 21). The Examiner notes that Angles discloses that the advertisement provider "selects an appropriate advertisement based on the consumer's profile" (col 8, lines 58-61) which "can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer's Internet provider, other account information, etc." (col 14, lines 19-23). The content provider also registers with the advertisement provider and supplies demographic data which includes "the content provider's website address, the name of the content provider, the type of products and services sold by the content provider, the size of the content provider, the content

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provider's account information, etc.” (col 14, lines 36-40). The advertisement provider then selects an appropriate advertisement either using only the consumer profile, or “both the consumer profile and content provider information” (col 15, lines 23-28). The advertisement database from which the targeted advertisement is selected “contains numerous advertisements which have been designed for different types of consumers” (col 15, lines 33-35) with “different versions of the advertisement are organized in the advertisement database 70 into difference demographic categories which can be defined by the advertisement provider” (col 15, lines 39-42). Thus, Angles explicitly discloses grouping and subdividing advertisement from a plurality of advertisers according to topic, user profiles, and other criteria.

F. The Applicant argues in reference to Claims 40-43 and 57-63 that Logan requires the use of a “player” and thus fails to teach “transmitting and embedding a functional host”. The Examiner notes that these features were present in Angles, the main reference. As discussed in the rejection of these claims above, Angles already discloses presenting a series of customized advertisement if the consumer views a content page for more than a specified amount of time. Logan's disclosure of using a queue to identify the series of advertisements to be presented in an obvious method for Angles to use to update the customized advertisement.

G. The Applicant argues in reference to Claims 11 and 66-73 that Angles does not disclose that “the revenue paid to the content providers is based on a revenue pool of a plurality of advertisers” (page 23). This argument has been discussed at length above. The argument that Angles “discloses that the advertisers are still required to track client activity” is incorrect in that

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Angles explicitly discloses that "the consumer control module 42 sends a message to the advertising module 62 that the consumer has selected the customized advertisement 30. In response, the advertising module 62 stores the message in the accounting database 72" (col 20, lines 22-26). The advertising module and the accounting database are both components of the advertisement provider computer, not the advertiser's computer.

H. The Applicant's arguments in reference to Claims 76, 77, 80, and 81 pertaining to the feature of exchanging coupons with other clients on the network has been addressed in the rejection of these claims above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


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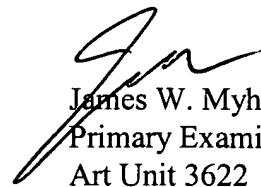
will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
April 29, 2003


James W. Myhre
Primary Examiner
Art Unit 3622